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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/811,395	03/29/2004	Toshiki Taguchi	Q80750	3069

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SUGHRUE MION, PLLC  
2100 PENNSYLVANIA AVENUE, N.W.  
SUITE 800  
WASHINGTON, DC 20037

EXAMINER

KLEMANSKI, HELENE G

ART UNIT PAPER NUMBER

1755

DATE MAILED: 03/24/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

*Carl*

<b>Office Action Summary</b>	<b>Application No.</b> 10/811,395	<b>Applicant(s)</b> TAGUCHI, TOSHIKI	
	<b>Examiner</b> Helene Klemanski	<b>Art Unit</b> 1755	

**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-11 is/are pending in the application.  
     4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-11 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
     Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
     Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
     a) ☒ All    b) ☐ Some \* c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. ____. |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date ____. | 6) <input type="checkbox"/> Other: ____.  |

## **DETAILED ACTION**

### ***Specification***

1. The disclosure is objected to because of the following informalities: On pages 4-15, applicants refer to the claims which is considered improper because there is no guarantee that those claims will issue and that their claim numbers will be the same as those mentioned in the specification when issued. The examiner suggests the deletion of the reference to the claims from the specification.

Appropriate correction is required.

### ***Double Patenting***

2. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

3. Claims 1 and 2 are rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-3, 5 and 11-13 of U.S. Patent No. 6,874,882. Although the conflicting claims are not identical, they are not patentably distinct from each other because the claims of the present application overlap said patent claims and would be obvious thereby.

4. Claims 3, 4, 6 and 7 are rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-4, 7, 9, 14, 17, 20, 21, 25 and 27 of U.S. Patent No. 6,800,673. Although the conflicting claims are not identical, they are not patentably distinct from each other because the claims of the present application overlap said patent claims and would be obvious thereby.

5. Claims 1 and 2 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1, 2 and 4-19 of copending Application No. 10/809,954 (US 2004/0194659). Although the conflicting claims are not identical, they are not patentably distinct from each other because the claims of the present application overlap said copending claims and would be obvious thereby.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

6. Claims 1 and 2 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1 and 12 of copending Application No. 10/671,729 (US 2004/0070654). Although the conflicting claims are not identical, they are not patentably distinct from each other because the

claims of the present application overlap said copending claims and would be obvious thereby.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

7. Claims 1 and 2 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1 and 12 of copending Application No. 10/645,795 (US 2004/0050291). Although the conflicting claims are not identical, they are not patentably distinct from each other because the claims of the present application overlap said copending claims and would be obvious thereby.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

### ***Claim Rejections - 35 USC § 102***

8. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

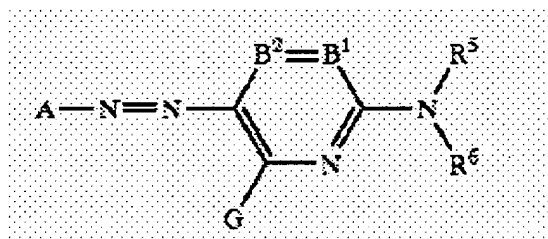
(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

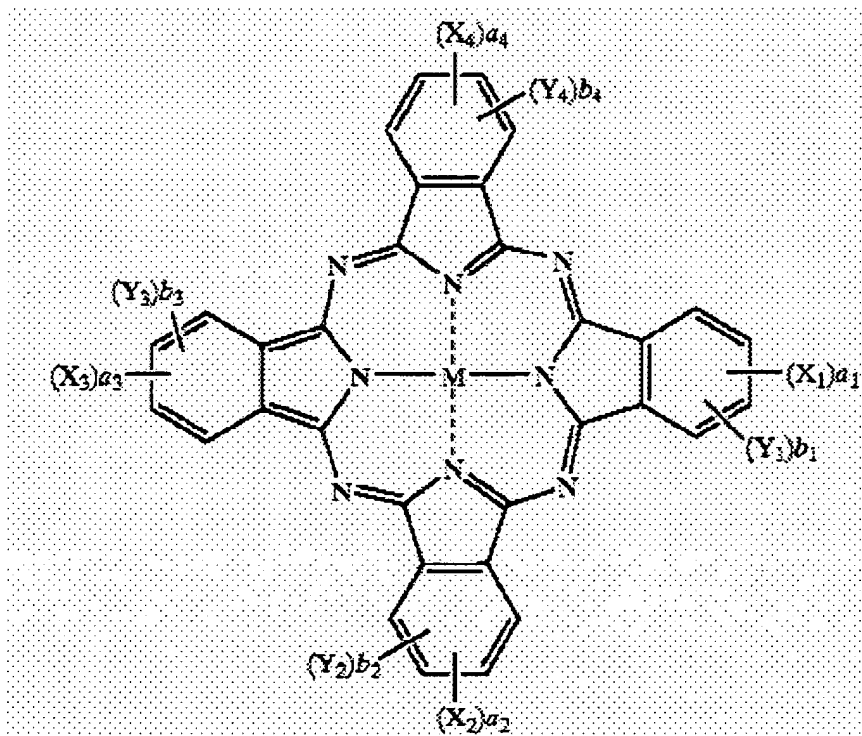
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9. Claims 3, 4, 6 and 7 are rejected under 35 U.S.C. 102(b) as being anticipated by Yamanouchi et al. (US 2002/0107301).

Yamanouchi et al. teach an ink for ink jet recording comprising polymer latex added to a colored fine particle dispersion containing at least a hydrophobic high boiling organic solvent and an oil soluble dye of the formula



wherein the substituents are defined in the specification or of the formula

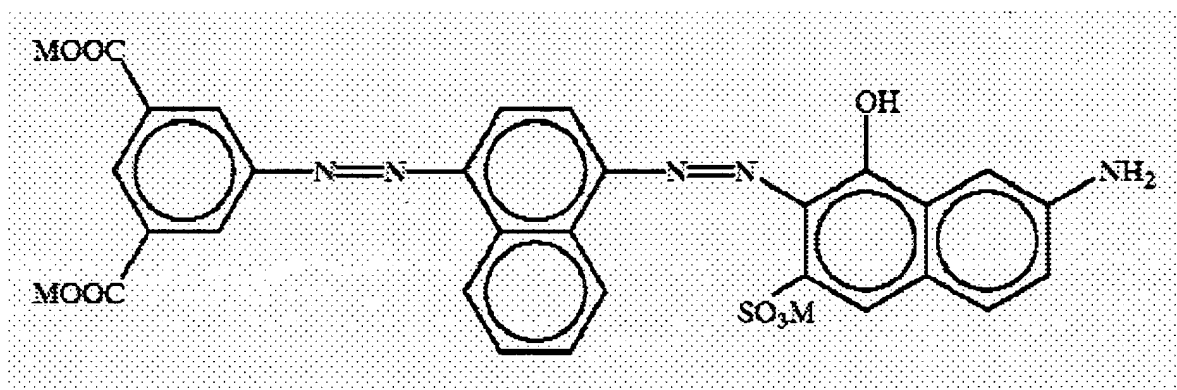


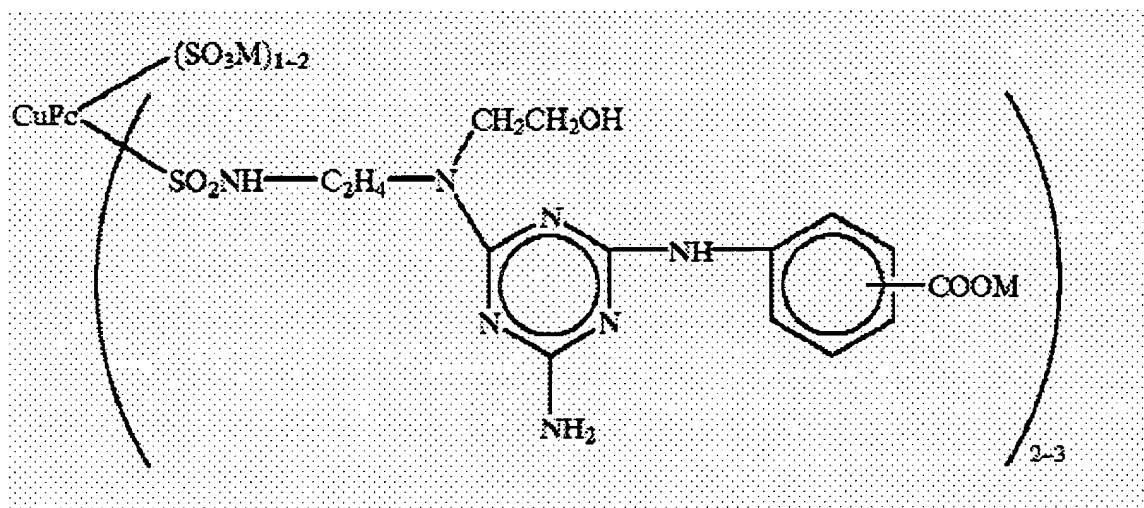
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wherein the substituents are defined in the specification dispersed in an aqueous medium. Yamanouchi et al. further teach an ink jet printing method comprising ejecting the above ink set onto a recording medium. See paras. 0013-0016, paras. 0019-0021, paras. 0102-0107, the azo dyes on pages 19-27, paras. 0175-0179, the phthalocyanine dyes on pages 33-36, para. 0301, paras. 0318-0320, paras. 0330-0380, paras. 0391, para. 0414, Table 19; Inks 203-205 and 207-209 and claims 1-3, 8-10, 17, 18, 21 and 22. The inkjet ink as taught by Yamanouchi et al. appears to anticipate the present claims.

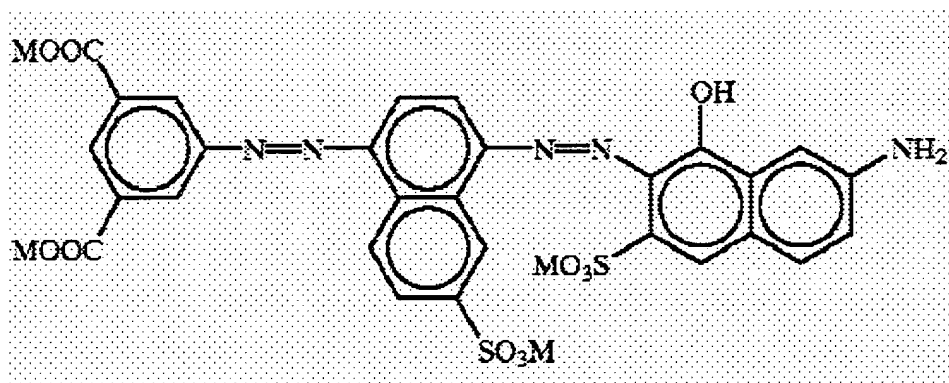
10. Claims 8-11 are rejected under 35 U.S.C. 102(b) as being anticipated by Katsuragi et al. (US 6,533,406).

Katsuragi et al. teach an ink set comprising a first liquid containing a polyvalent metal salt of a polyol phosphate, a liquid medium and optionally a colorant and a second liquid (i.e. ink composition) containing a coloring material such as a dye that is capable of reacting with the polyvalent metal salt of the polyol phosphate and a liquid medium. The dyes are preferably of the formula





or



(i.e. dyes of

applicant's formulas 2 or 4). Katsuragi et al. further teach an ink jet printing method comprising applying the above two liquids to a recording medium and wherein the order of the liquid composition and the ink applied is optional i.e. either the liquid composition is printed first and then the ink or vice versa. See col. 2, lines 9-20 and lines 53-65, col. 3, lines 1-7 and lines 34-50, col. 4, lines 55-65, col. 5, lines 1-45, col. 6, lines 45-50, exemplary compounds 1, 4 and 5, col. 16, lines 3-35, col. 17, lines 35-40 and lines 53-55, col. 18, lines 29-31, col. 25, lines 35-37, Liquid Compositions 1-3, Black Ink 3, Cyan Ink 2, Table 1; examples 3, 9, 12 and 18, Table 2; examples 20 and 22 and claims 1, 2

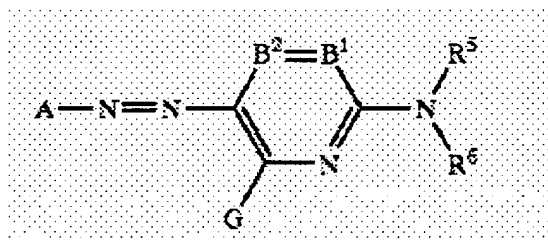


and 14. The ink set as taught by Katsuragi et al. appears to anticipate the present claims.

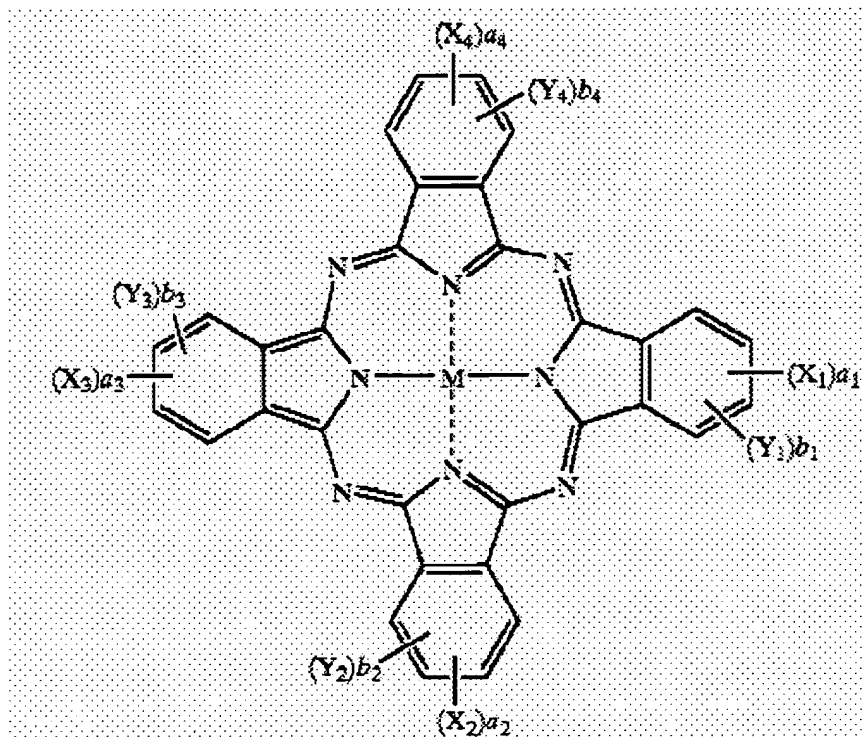
11. Claims 1 and 2 are rejected under 35 U.S.C. 102(e) as being anticipated by Taguchi et al. (US 6,874,882)

The applied reference has a common inventor with the instant application. Based upon the earlier effective U.S. filing date of the reference, it constitutes prior art under 35 U.S.C. 102(e). This rejection under 35 U.S.C. 102(e) might be overcome either by a showing under 37 CFR 1.132 that any invention disclosed but not claimed in the reference was derived from the inventor of this application and is thus not the invention "by another," or by an appropriate showing under 37 CFR 1.131.

Taguchi et al. teach an inkjet ink set comprising at least three kinds of inkjet inks, each comprising a coloring agent dissolved or dispersed in an aqueous or oily medium wherein the ratio of any two of the forced discoloration rate constants is from 0.5 to 2.0. The inkjet ink set preferably comprises a magenta ink, a light magenta ink, a cyan ink, a light cyan ink, a yellow ink, a light yellow ink and a black ink. The magenta and light magenta inks each comprise an azo dye of the formula



wherein the substituents are defined in the specification. The cyan and light cyan inks each comprise a phthalocyanine dye having an oxidation potential of higher than 1.0 V (vs SCE) of the formula



wherein the substituents are defined in the specification. The yellow and light yellow inks each contain a yellow dye such as an aryl- or heteryl-azo dye. The black ink contains a coloring including a dye and/or pigment. The aqueous medium comprises a mixture of water and a water-miscible organic solvent such as ethylene glycol. A water-soluble polymer such as a polymer latex may also be added to the ink compositions for the purpose of stabilizing the dispersion and/or as a viscosity adjusting agent. The polymer preferably contains  $\text{SO}_3^-$  or  $\text{COO}^-$  groups. Taguchi et al. further teach an ink jet printing method comprising ejecting the above ink set onto a recording medium. See col. 2, line 26 – col. 4, line 18, col. 6, lines 5-65, col. 9, line 32 – col. 10, lines 10, col. 15, line 65 – col. 17, line 2, the azo dyes in col. 19 – col. 50, col. 51, lines 1-54, col. 63, line 14, the phthalocyanine dyes in col. 63 – col. 90, col. 91, lines 56-61, col. 92, lines 10-42, col. 94, lines 31-50, col. 99, line 60 – col. 100, line 26, example 1, Table 25,

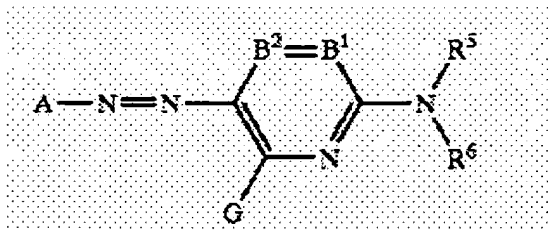
example 2 and claims 1-3, 5 and 11-13. The inkjet ink set as taught by Taguchi et al. appears to anticipate the present claims.

12. Applicant cannot rely upon the foreign priority papers to overcome this rejection because a translation of said papers has not been made of record in accordance with 37 CFR 1.55. See MPEP § 201.15.

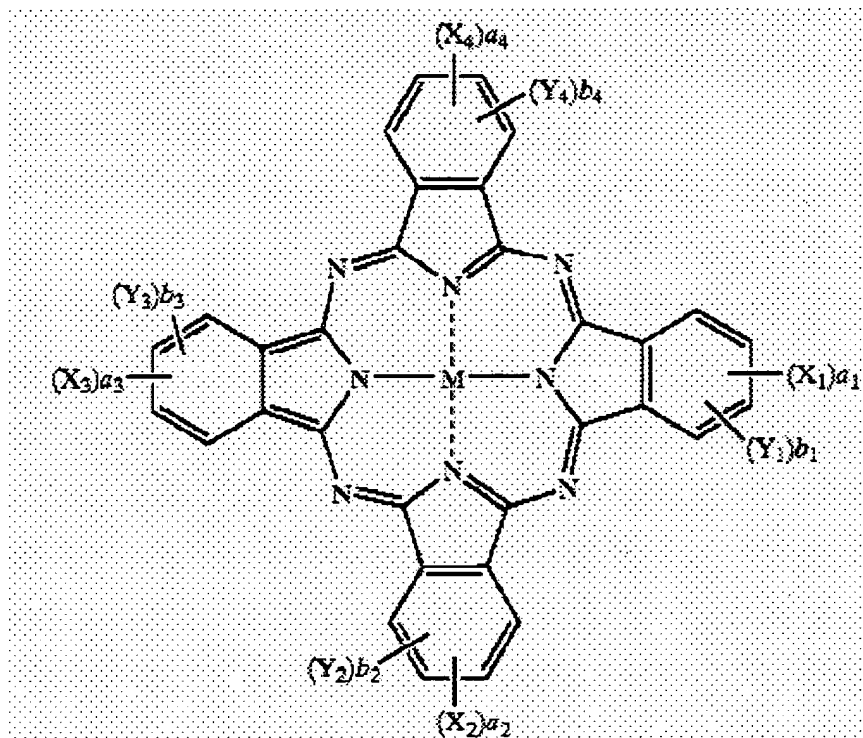
13. Claims 3, 4, 6 and 7 are rejected under 35 U.S.C. 102(e) as being anticipated by Yamanouchi et al. (US 6,600,673)

The applied reference has a common inventor with the instant application. Based upon the earlier effective U.S. filing date of the reference, it constitutes prior art under 35 U.S.C. 102(e). This rejection under 35 U.S.C. 102(e) might be overcome either by a showing under 37 CFR 1.132 that any invention disclosed but not claimed in the reference was derived from the inventor of this application and is thus not the invention "by another," or by an appropriate showing under 37 CFR 1.131.

Yamanouchi et al. teach an ink for ink jet recording comprising a water-insoluble ionic group containing polymer such as vinyl, polyurethane or polyester polymer added to a colored fine particle dispersion containing at least a hydrophobic high boiling organic solvent and an oil soluble dye of the formula



wherein the substituents are defined in the specification or of the formula



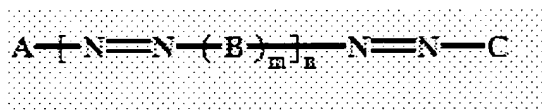
wherein the substituents are defined in the specification dispersed in an aqueous medium. Yamanouchi et al. further teach an ink jet printing method comprising ejecting the above ink set onto a recording medium. See col. 2, lines 36-43, col. 3, lines 45-61, col. 4, lines 1-39, col. 23, lines 9-50, the azo dyes in col. 29 – col. 45, col. 45, line 20 – col. 46, line 30, the phthalocyanine dyes in col. 55 – col. 61, col. 74, lines 45-48, col. 76, lines 39-52, col. 77, lines 45-60, col. 78, lines 8-50, col. 82, lines 64-67, col. 86, lines 4-7, col. 88, lines 1-26, col. 89, lines 33-37, Table 12, col. 93, lines 40-50, Table 13; Inks 102-110, Table 15; Ink Sets 202-206, Table 16, Ink Sets 208-210 and 212-214, example 4, Table 21; Ink Sets 303-305 and 307-309 and claims 1-4, 7, 9, 14, 17, 20, 21, 25 and 27. The inkjet ink as taught by Yamanouchi et al. appears to anticipate the present claims.

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14. Claims 1 and 2 are rejected under 35 U.S.C. 102(e) as being anticipated by Taguchi et al. (US 2004/0070654)

The applied reference has a common inventor with the instant application. Based upon the earlier effective U.S. filing date of the reference, it constitutes prior art under 35 U.S.C. 102(e). This rejection under 35 U.S.C. 102(e) might be overcome either by a showing under 37 CFR 1.132 that any invention disclosed but not claimed in the reference was derived from the inventor of this application and is thus not the invention "by another," or by an appropriate showing under 37 CFR 1.131.

Taguchi et al. teach a black ink for ink jet recording comprising a dye of the formula



wherein A, B and C each independently represent an aromatic or heterocyclic group, which are substituted or unsubstituted; m is 1 or 2 and n is an integer of 0 or more dissolved or dispersed in an aqueous medium. The aqueous medium comprises a mixture of water and a water-miscible organic solvent such as ethylene glycol. A water-soluble polymer such as a polymer latex may also be added to the ink compositions for the purpose of stabilizing the dispersion and/or as a viscosity adjusting agent. The polymer preferably contains  $-SO_3^-$  or  $-COO^-$  groups. Taguchi et al. further teach an ink jet printing method comprising ejecting the above ink set onto a recording medium. See para. 0015, paras. 0031-0032, paras. 0059-0065, the azo dyes on pages 9-17, para. 0170, paras. 0175-0177, para. 0187, para. 0202, paras 0228-0230, paras. 0293-0294

and claims 1 and 12. The black inkjet ink as taught by Taguchi et al. appears to anticipate the present claims.

15. Applicant cannot rely upon the foreign priority papers to overcome this rejection because a translation of said papers has not been made of record in accordance with 37 CFR 1.55. See MPEP § 201.15.

16. Claims 1 and 2 are rejected under 35 U.S.C. 102(e) as being anticipated by Taguchi et al. (US 2004/0050291)

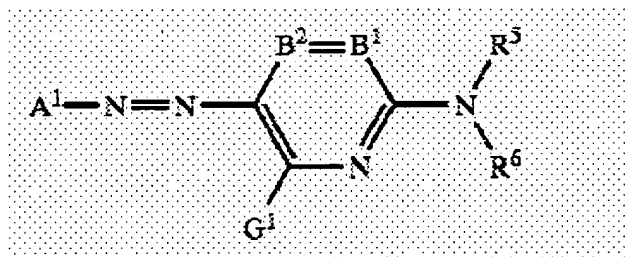
The applied reference has a common inventor with the instant application. Based upon the earlier effective U.S. filing date of the reference, it constitutes prior art under 35 U.S.C. 102(e). This rejection under 35 U.S.C. 102(e) might be overcome either by a showing under 37 CFR 1.132 that any invention disclosed but not claimed in the reference was derived from the inventor of this application and is thus not the invention "by another," or by an appropriate showing under 37 CFR 1.131.

Taguchi et al. teach an ink jet ink set comprising a yellow ink, a magenta ink, and a cyan ink, each ink comprising a dye, and an aqueous medium. The yellow ink contains a water-soluble yellow dye having an oxidation potential of higher than 1.0 V (vs SCE) of the formula

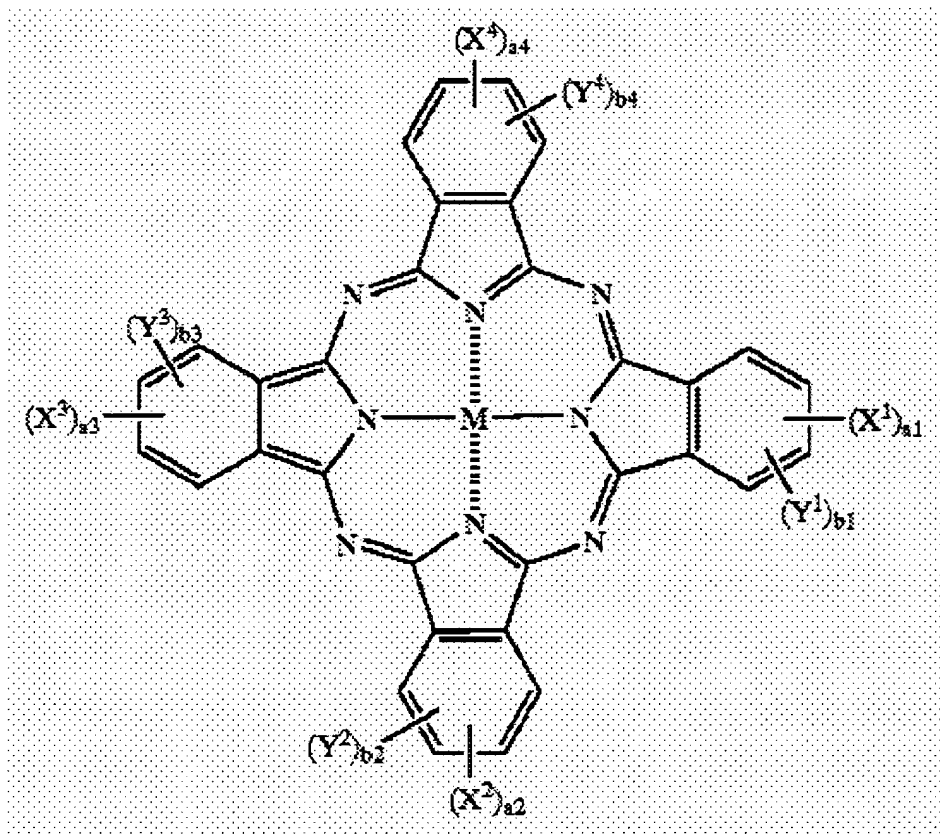
A-N=N-B

wherein A and B each independently represents a heterocyclic group which may be substituted. The magenta ink contains a water-soluble magenta dye of the formula

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wherein the substituents are defined in the specification. The cyan ink contains a water-soluble cyan dye having an oxidation potential more positive than 1.0 V (vs SCE) of the formula



wherein the substituents are defined in the specification. The aqueous medium comprises a mixture of water and a water-miscible organic solvent such as ethylene glycol. A water-soluble polymer such as a polymer latex may also be added to the ink compositions for the purpose of stabilizing the dispersion and/or as a viscosity adjusting

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agent. The polymer preferably contains  $-\text{SO}_3^-$  or  $-\text{COO}^-$  groups. Taguchi et al. further teach an ink jet printing method comprising ejecting the above ink set onto a recording medium. See para. 0010, paras. 0015-0021, para. 0029, paras. 0040-0041, paras. 0047-0050, para. 0074, yellow dye formulas on pages 7-12, para. 0098, para. 0135, magenta dye formulas on pages 18-34, paras. 0165-0166, para. 0169, cyan dye formulas on pages 42-58, para. 0246, para. 0257, para. 0262, para. 0266, para. 0277, example 1, Ink Sets 102-105 in Table B and claims 1 and 4-6. The ink jet ink set as taught by Taguchi et al. appears to anticipate the present claims.

17. Applicant cannot rely upon the foreign priority papers to overcome this rejection because a translation of said papers has not been made of record in accordance with 37 CFR 1.55. See MPEP § 201.15.

### ***Claim Rejections - 35 USC § 103***

18. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

19. Claims 3-7 are rejected under 35 U.S.C. 103(a) as being obvious over Taguchi et al. (US 6,874,882).

The applied reference has a common inventor with the instant application.

Based upon the earlier effective U.S. filing date of the reference, it constitutes prior art only under 35 U.S.C. 102(e). This rejection under 35 U.S.C. 103(a) might be overcome



by: (1) a showing under 37 CFR 1.132 that any invention disclosed but not claimed in the reference was derived from the inventor of this application and is thus not an invention "by another"; (2) a showing of a date of invention for the claimed subject matter of the application which corresponds to subject matter disclosed but not claimed in the reference, prior to the effective U.S. filing date of the reference under 37 CFR 1.131; or (3) an oath or declaration under 37 CFR 1.130 stating that the application and reference are currently owned by the same party and that the inventor named in the application is the prior inventor under 35 U.S.C. 104, together with a terminal disclaimer in accordance with 37 CFR 1.321(c). This rejection might also be overcome by showing that the reference is disqualified under 35 U.S.C. 103(c) as prior art in a rejection under 35 U.S.C. 103(a). See MPEP § 706.02(I)(1) and § 706.02(I)(2).

Taguchi et al. is cited and relied upon for the above stated reasons. Taguchi et al. fails to specifically exemplify the addition of a polymer compound to the ink composition as claimed by applicants.

Therefore, it would have been obvious to one having ordinary skill in the art to use the specific ink composition containing a polymer as claimed by applicants as Taguchi et al. also discloses the use of these polymers but fails to show an example incorporating them.

20. Applicant cannot rely upon the foreign priority papers to overcome this rejection because a translation of said papers has not been made of record in accordance with 37 CFR 1.55. See MPEP § 201.15.

21. Claims 3-7 are rejected under 35 U.S.C. 103(a) as being obvious over Taguchi et al. (US 2004/0070654).

The applied reference has a common inventor with the instant application. Based upon the earlier effective U.S. filing date of the reference, it constitutes prior art only under 35 U.S.C. 102(e). This rejection under 35 U.S.C. 103(a) might be overcome by: (1) a showing under 37 CFR 1.132 that any invention disclosed but not claimed in the reference was derived from the inventor of this application and is thus not an invention "by another"; (2) a showing of a date of invention for the claimed subject matter of the application which corresponds to subject matter disclosed but not claimed in the reference, prior to the effective U.S. filing date of the reference under 37 CFR 1.131; or (3) an oath or declaration under 37 CFR 1.130 stating that the application and reference are currently owned by the same party and that the inventor named in the application is the prior inventor under 35 U.S.C. 104, together with a terminal disclaimer in accordance with 37 CFR 1.321(c). This rejection might also be overcome by showing that the reference is disqualified under 35 U.S.C. 103(c) as prior art in a rejection under 35 U.S.C. 103(a). See MPEP § 706.02(l)(1) and § 706.02(l)(2).

Taguchi et al. is cited and relied upon for the above stated reasons. Taguchi et al. fails to specifically exemplify the addition of a polymer compound to the ink composition as claimed by applicants.

Therefore, it would have been obvious to one having ordinary skill in the art to use the specific ink composition containing a polymer as claimed by applicants as

Taguchi et al. also discloses the use of these polymers but fails to show an example incorporating them.

22. Applicant cannot rely upon the foreign priority papers to overcome this rejection because a translation of said papers has not been made of record in accordance with 37 CFR 1.55. See MPEP § 201.15.

23. Claims 3 and 5-7 are rejected under 35 U.S.C. 103(a) as being obvious over Taguchi et al. (US 2004/0050291).

The applied reference has a common inventor with the instant application. Based upon the earlier effective U.S. filing date of the reference, it constitutes prior art only under 35 U.S.C. 102(e). This rejection under 35 U.S.C. 103(a) might be overcome by: (1) a showing under 37 CFR 1.132 that any invention disclosed but not claimed in the reference was derived from the inventor of this application and is thus not an invention "by another"; (2) a showing of a date of invention for the claimed subject matter of the application which corresponds to subject matter disclosed but not claimed in the reference, prior to the effective U.S. filing date of the reference under 37 CFR 1.131; or (3) an oath or declaration under 37 CFR 1.130 stating that the application and reference are currently owned by the same party and that the inventor named in the application is the prior inventor under 35 U.S.C. 104, together with a terminal disclaimer in accordance with 37 CFR 1.321(c). This rejection might also be overcome by showing that the reference is disqualified under 35 U.S.C. 103(c) as prior art in a rejection under 35 U.S.C. 103(a). See MPEP § 706.02(I)(1) and § 706.02(I)(2).

Taguchi et al. is cited and relied upon for the above stated reasons. Taguchi et al. fails to specifically exemplify the addition of a polymer compound to the ink composition as claimed by applicants.

Therefore, it would have been obvious to one having ordinary skill in the art to use the specific ink composition containing a polymer as claimed by applicants as Taguchi et al. also discloses the use of these polymers but fails to show an example incorporating them.

24. Applicant cannot rely upon the foreign priority papers to overcome this rejection because a translation of said papers has not been made of record in accordance with 37 CFR 1.55. See MPEP § 201.15.

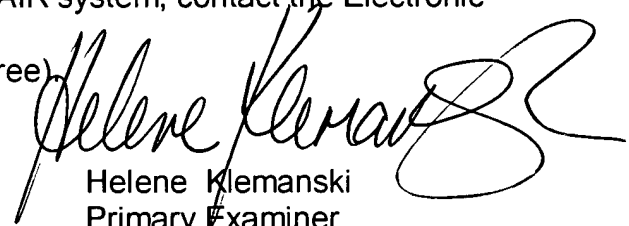
### ***Conclusion***

The remaining references listed on forms 892 and 1449 have been reviewed by the examiner and are considered to be cumulative to or less material than the prior art references relied upon in the above rejections.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Helene Klemanski whose telephone number is (571) 272-1370. The examiner can normally be reached on Monday-Friday 5:30-2:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jerry Lorengo can be reached on (571) 272-1233. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Helene Klemanski  
Primary Examiner  
Art Unit 1755



HK  
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